IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants: Oliver et al.

Serial No.:   10/815,511

For: USE OF NODES TO MONITOR OR MANAGE PEER TO PEER
NETWORKS

Filed: 1 APR 2004

Examiner: Dady Chery

Art Unit: 2616

Confirmation No.:   1299

Customer No.:   27,623   Attorney Docket Nos.: 300203615-4
976.8021USU1

APPEAL BRIEF FILED UNDER 35 U.S.C. §134
(corrected sections (vi) and (vii))

Mail Stop Appeal Brief - Patents
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

On 25 JUL 2008, Appellants mailed an Appeal Brief for the above-noted application. On 10 JUL 2008, the Office mailed a Notice of Non-Compliant Appeal Brief (hereinafter "the Notice").

The Notice indicates that sections (vi) and (vii) of the Appeal Brief are non-compliant because they refer to claim 5, but claim 5 is canceled. Accordingly, Appellants are providing below, a revised version of sections (vi) and (vii) that avoids the references to claim 5.

(vi) Grounds of Rejection to be Reviewed on Appeal

The first issue presented for review is the propriety of the Examiner's final rejection of claim 16 under 35 U.S.C. 101 as being directed to non-statutory subject matter.

The second issue presented for review is the propriety of the Examiner's final rejection of claims 1, 11, 16 and 17 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The third issue presented for review is the propriety of the Examiner's final rejection of claims 1 – 3 and 11 - 26 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 7,127,613 to Pabla et al. (hereinafter "the Pabla et al. patent").

The fourth issue presented for review is the propriety of the Examiner's final rejection of claim 4 under 35 U.S.C. 103(a) as being unpatentable over the Pabla et al. patent in view of U.S. Patent No. 7,137,145 to Gleichauf (hereinafter "the Gleichauf patent"), in further view of a document by Golle (hereinafter "the Golle document").

(vii) Argument

(1)   The first issue presented for review is the propriety of the Examiner's final rejection of claim 16 under 35 U.S.C. 101 as being directed to non-statutory subject matter.

Claim 16 provides for a data storage media comprising program data for controlling a first computer entity to perform a method that includes:

operating a peer to peer protocol for enabling said first computer entity to utilise a resource of a second computer entity in a peer to peer network, and for enabling said second computer entity to utilise a resource of said first computer entity in said peer to peer network; and

operating a process for managing said second computer entity,

wherein said process utilises said resource of said first computer entity, and is invoked when said resource of said first computer entity is not being used by a service application at a higher level layer than said peer to peer protocol.

2

The Office Action, in section 1, contends that the claim 16 is directed to non-statutory subject matter. Appellants respectfully disagree.

"Functional descriptive material" consists of data structures and computer programs that impart functionality when employed as a computer component. When functional descriptive material is recorded on some computer readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized (MPEP 2106.01).

A computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. (MPEP 2106.01, citing *In re Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035).

Appellants submit that whereas claim 16 recites a **data storage media** comprising **program data** for **controlling a first computer entity to perform a method** that includes operating a peer to peer protocol, and **operating a process for managing said second computer entity**, it recites <u>a computer-readable medium</u> encoded with a computer <u>program</u> that is a computer element that <u>defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized</u>, and is thus <u>statutory</u>. Accordingly, Appellants submit that claim 16 fulfills the requirements of 35 U.S.C. 101.

Appellants are requesting a withdrawal of the section 101 rejection of claim 16.

(2) The second issue presented for review is the propriety of the Examiner's final rejection of claims 1, 11, 16 and 17 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

NOTE: The Office Action, in section 2, presents several passages that are purportedly quotations from claims 1, 11, 16 and 17. However, none of claims 1, 11, 16 or 17 includes any of the quoted passages. For example, each of the quoted passages includes the phrase, "a third computer entity', but

3

none of claims 1, 11, 16 or 17 includes a recital of "a third computer entity." Nevertheless, below, Appellants are explaining that the claims comply with the written description.

(a)   Claim 1 stands alone

Claim 1 is an independent claim. Above, under the heading "(v) Summary of Claimed Subject Matter", and more specifically, under the sub-heading "Concise Explanation of Each of the Independent Claims", Appellants provided an explanation of claim 1 that refers to the specification by page and line number, and refers to the figures by reference characters. Accordingly, Appellants submit that claim 1 complies with the written description.

Appellants are requesting a withdrawal of the section 112 rejection of claim 1.

(b)   Claim 11 stands alone

Claim 11 is an independent claim. Above, under the heading "(v) Summary of Claimed Subject Matter", and more specifically, under the sub-heading "Concise Explanation of Each of the Independent Claims", Appellants provided an explanation of claim 11 that refers to the specification by page and line number, and refers to the figures by reference characters. Accordingly, Appellants submit that claim 11 complies with the written description.

Appellants are requesting a withdrawal of the section 112 rejection of claim 11.

(c)   Claim 16 stands alone

Claim 16 is an independent claim. Above, under the heading "(v) Summary of Claimed Subject Matter", and more specifically, under the sub-heading "Concise Explanation of Each of the Independent Claims", Appellants provided an explanation of claim 16 that refers to the specification by page and line number, and refers to the figures by reference characters. Accordingly, Appellants submit that claim 16 complies with the written description.

Appellants are requesting a withdrawal of the section 112 rejection of claim 16.

(d)   Claim 17 stands alone

Claim 17 is an independent claim. Above, under the heading "(v) Summary of Claimed Subject Matter", and more specifically, under the sub-heading "Concise Explanation of Each of the Independent Claims", Appellants provided an explanation of claim 17 that refers to the specification by page and line number, and refers to the figures by reference characters. Accordingly, Appellants submit that claim 17 complies with the written description.

Appellants are requesting a withdrawal of the section 112 rejection of claim 17.

(3)   The third issue presented for review is the propriety of the Examiner's final rejection of claims 1 – 3 and 11 - 26 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 7,127,613 to Pabla et al. (hereinafter "the Pabla et al. patent").

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

In order to anticipate a claim under Section 102 and render it unpatentable, a single prior art reference must not only expressly or inherently disclose each and every element set forth in the claim, but the reference must also be enabling, i.e. it must clearly put the claimed subject matter in the possession of the public. *In re Brown*, 329 F. 2d 1066, 144 USPQ 245 (CCPA 1964); *In re Kalm*, 378 F. 2d 959, 1154 USPQ 10 (CCPA 1967); *Rem-Cru Titanium, Inc. v. Watson*, 147 F. Supp. 915 112 USPQ 88 (Dist. Ct., DC 1956); *Akzo N.V. v. United States ITC*, 808 F 2d 1471, 1 USPQ 2d 1241 (Fed. Cir. 1986); and *In re Spada*, 911 F 2d 705, 15 USPQ 2d 1655 (Fed. Cir. 1990). The mere disclosure of concepts does not anticipate.

(a)   Claims 1 – 3, 11 – 18 and 21 – 24 stand or fall together

Claim 1 provides for a method performed by a first computer entity. The method includes, *inter alia*, operating a peer to peer protocol, and operating a process for managing a second computer entity.

The process utilises a resource of the first computer entity, and is invoked when the resource is not being used by a service application at a higher level layer than the peer to peer protocol.

NOTE: The Office Action, on page 7, appears to suggest that claim 1 includes a recital of "operating a process, in cooperation with a third computer entity." However, claim 1 does not mention a third computer entity.

Nevertheless, the Office Action, on page 7, suggests that several passages in the Pabla et al. patent are descriptive of operating a process for managing the second computer entity. Table 1, below, briefly summarizes the substance of each of the several passages.

TABLE 1

Pabla et al. (citation)	Summary of substance of cited passage
col. 12, lines 60 - 62	Mechanisms with which peers may find each other, cooperate with each other, and communicate with each other.
col. 13, lines 51 - 53	Peers may cooperate and communicate with each other by following a set of rules and conventions
col. 18, lines 17 – 39 and 43 - 50	Concerns joining a peer group, voting, finding a peer, and searching for peers
col. 19, lines 32 - 39	Sharing resources
col. 22, lines 17 – 21	Peer group service
col. 1, lines 32 - 34	Client/server relationships

None of the above-noted passages of the Pabla et al. patent appears to involve a computer entity managing another computer. But regardless of whether these passages involve a computer entity managing another computer, the Pabla et al. patent does not mention any particular criteria for invoking the processes described in the passages, and none of them is described as being invoked when some other resource is not being used. Thus, the Pabla et al. patent does not appear to disclose a method that includes a first computer entity operating a process that utilises a resource of the first computer entity, and is **invoked when the resource is not being used** by a service application at a higher level layer than the peer to peer protocol, as recited in claim 1. Accordingly, Appellants submit that the Pabla et al. patent does not anticipate claim 1.

Claims 2 and 3 depend from claim 1. By virtue of this dependence, claims 2 and 3 are also novel over the Pabla et al. patent.

Claim 11 is an independent claim and includes a recital, similarly to claim 1, of a process that is invoked when a resource is not being used. Thus, claim 11, similarly to claim 1, is also novel over the Pabla et al. patent.

Claims 12 – 15 depend from claim 1. By virtue of this dependence, claims 12 – 15 are also patentable over the Pabla et al. patent.

Claim 16 is an independent claim and includes a recital, similarly to claim 1, of a process that is invoked when a resource is not being used. Thus, claim 16, similarly to claim 1, is also novel over the Pabla et al. patent.

Claim 17 is an independent claim and includes a recital, similarly to claim 1, of a process that is invoked when a resource is not being used. Thus, claim 17, similarly to claim 1, is also novel over the Pabla et al. patent.

Claim 18 depends from claim 17. By virtue of this dependence, claim 18 is also novel over the Pabla et al. patent.

Claims 21, 22, 23 and 24 depend from claims 1, 11, 16 and 17, respectively. By virtue of these dependencies, claims 21 – 24 are also novel over the Pabla et al. patent.

Appellants are requesting a withdrawal of the section 102(e) rejection of claims 1 – 3, 11 – 18 and 21 – 24.

(b)   Claims 19 and 20 stand or fall together

Claim 19 provides for a method performed by a first computer entity. The method includes operating a process for managing a second computer entity, in response to receipt of a service request from a third computer entity.

The Office Action, at the top of page 11, suggests that the Pabla et al. patent describes the above-noted feature of claim 19, with reference to FIG. 13, and a passage at col. 20, line 44 – col. 21, line 16. Appellants respectfully disagree with the Office Actions assessment of the Pabla et al. patent.

The Pabla et al. patent, FIG 13 is a diagram illustrating <u>two peers</u> using a shared layered sharing policy and several protocols to share content (col. 20, lines 44 – 46). The passage at col. 20, line 44 – col. 21, line 16 does not appear to involve <u>a third peer</u>, and does not mention <u>a service request from a third peer</u>. The Pabla et al. patent does not describe operating a process for managing a second computer entity, in response to receipt of **a service request from a third computer entity**, as recited in claim 19. Accordingly, Appellants submit that the Pabla et al. patent does not anticipate claim 19.

Claim 20 is an independent claim and includes a recital, similarly to claim 19, of a response to a service request from a third computer entity. Thus, claim 20, similarly to claim 19, is also novel over the Pabla et al. patent.

Appellants are requesting a withdrawal of the section 102(e) rejection of claims 19 and 20.

(4)   The fourth issue presented for review is the propriety of the Examiner's final rejection of claim 4 under 35 U.S.C. 103(a) as being unpatentable over the Pabla et al. patent in view of U.S. Patent No. 7,137,145 to Gleichauf (hereinafter "the Gleichauf patent"), in further view of a document by Golle (hereinafter "the Golle document").

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Furthermore, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Claim 4 depends from claim 1. Appellants respectfully submit that the cited combination of the Pabla et al. patent, the Gleichauf patent, and the Golle document does not disclose or suggest a method that includes a first computer entity operating a process that utilises a resource of the first computer entity, and is invoked when the resource is not being used by a service application at a higher level

8

layer than the peer to peer protocol, as recited in claim 1. Accordingly, Appellants submit that claim 1, and claim 4, by virtue of its dependence on claim 1, are both patentable over the cited combination of the Pabla et al. patent, the Gleichauf patent, and the Golle document.

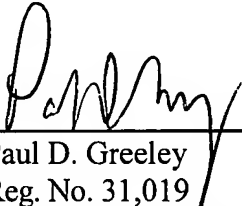Appellants are requesting a withdrawal of the section 103(a) rejection of claim 1.

In view of the foregoing arguments, Appellants respectfully request that the Board of Appeals reverse the final rejection of claims 1 – 4 and 11 – 26.

Appellants note that the Office Action, on pages 5 – 6, claims 1 – 4, 11 – 16 and 18 – 22 are provisionally rejected on the grounds of non-statutory obviousness-type double patenting. Whereas the rejection is a provisional rejection, Appellants will address it when the claims of the present application are found to be otherwise allowable.

Respectfully submitted,

_____8|1|08_____   _____
Date   Paul D. Greeley
                                                Reg. No. 31,019
                                                Attorney for the Appellants
                                                Ohlandt, Greeley, Ruggiero & Perle, L.L.P.
                                                One Landmark Square, 10th Floor
                                                Stamford, CT 06901-2682
                                                Tel: 203-327-4500
                                                Fax: 203-327-6401